

REMARKS

I. Introduction

Claims 1-43 are pending in the application. Claims 1, 6-7, 31, and 39 are independent. Claim 8 stands objected to, and all claims stand rejected. In particular:

(A) claim 43 stands rejected under 35 U.S.C. §112 second paragraph

(B) claims 39-43 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 5,769,269 (hereinafter "Peters");

(C) claims 1-4 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,324,520 (hereinafter "Walker") in view of "PTS: Vending Machine Refund System" (hereinafter "PTS");

(D) claim 5 stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of PTS, in further view of U.S. Patent No. 7,286,901 (hereinafter "Whitten");

(E) claim 6 stands rejected under 25 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,772,906 (hereinafter "Wittern Jr."), PTS and Walker;

(F) claims 7, 8, 17, 19-22 and 25-29 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of U.S. Patent No. 6,606,602 (hereinafter "Kolls");

(G) claims 9 and 10 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Kolls and in further view of PTS;

(H) claims 11 and 18 stand rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr.;

(I) claim 12 stands rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr. and Peters;

(J) claim 13 stands rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr. and US. Publication No. US2003/0176213 (hereinafter "LeMay");

(K) claims 14 and 15 stand rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr. and US. Patent No. 5,575,067 (hereinafter "Blad");

(L) claim 16 stands rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr., Blad and PTS;

(M) claims 23, 24 and 30 stand rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Whitten; and

(O) claims 31-38 stand rejected under 35 U.S.C. §103(a) Walker in view of U.S. Patent Publication No. 2002/0099662 (hereinafter Joshi).

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. The Examiner's Objection

Claim 8 continues to stand objected to for allegedly failing to further limit the claim upon which it depends (claim 7). In response to Applicants' previous arguments on this point, the Examiner finds a new basis for the objection, stating that claim 7 recites "input received at the vending machine and from the customer" and that claim 8 "provides the same limitation" in reciting *receiving the input from the customer*.

Applicants respectfully traverse the Examiner's finding that claim 8 does not further limit claim 7, for at least the reason, as stated in previous replies, that in claim 7 the input is described as input received from the customer, but claim 7 does not affirmatively require a step of receiving the input from the customer. Also, claim 8 does not affirmatively require that the receiving of the input is by the vending machine. Accordingly, claim 8 does not provide the "same limitation."

However, solely in order to render this objection moot, and without conceding the propriety of the objection, Applicants have cancelled claim 8 without prejudice. Claim 9, which depended from claim 8, has been amended to depend from claim 7. Accordingly, Applicants request that the Examiner reconsider and withdraw the objection to claim 8.

Applicants further note that claim 7 has been amended to recite a feature of *receiving input at the vending machine and from the customer*. No new matter has been added.

III. The Examiner's Rejections

A. 35 U.S.C. §112(2) – Indefiniteness

Claim 43 stands rejected under 35 U.S.C. §112(2) as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. [page 3].

Applicants respectfully traverse these findings, and traverse the Examiner's reliance on them as the basis for finding Claim 43 is indefinite.

A description of how both genuineness and / or value may be assessed by a customer service representative, and how a resolution may be based on such assessment(s) is discussed at least at paragraph [0165] of the application as published. The relative value of a customer (e.g., to a business) may be assessed, in one example, by determining whether the customer is a loyal, repeat customer, or only a one-time, transactional customer. One of ordinary skill in the art would understand that customers may be assessed as having different values (e.g., to a business) based on, for example, their respective transaction histories with the business. Other examples of assessing genuineness include consideration of whether a customer is a valuable customer, and considering whether a customer has provided more than a threshold number of complaints. For at least these reasons, Applicants respectfully request the Examiner's reconsideration and withdrawal of the findings relied on in the Section 112(2) rejection of claim 43 for indefiniteness.

However, claim 43 has been cancelled without prejudice by this Amendment, rendering the Section 112(2) rejection moot. Applicants reserve the right to pursue the subject matter of claim 43 in this application and / or one or more continuing applications.

B. 35 U.S.C. §102(b) – Peters

Claims **39-43** stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Peters. Applicants traverse this ground for rejection as follows.

Applicants respectfully assert that the Examiner has failed to show how Peters teaches or suggests the specific combination of all of the limitations of claims **39-43**. Claim 39 is independent; claims 40-42 depend from claim 39 and claim 43 has been cancelled.

In drawing from disparate portions of Peters that describe different functionality provided according to different situations (e.g., where a product is dispensed but is the wrong product; where the product is not vended; where the customer used cash; where the customer used a credit card) it appears that the Examiner has failed to show how that Peters teaches the specific combination of features recited in claim 39. The Office Action fails to establish a prima facie case of anticipation by Peters for at least this reason, and Applicants respectfully request that the Examiner reconsider and withdraw the Section 102(b) rejection.

Further, claim 39 now recites a feature of wherein the resolution is based on at least one of: (i) an identity of the customer and (ii) an assessed value of the customer. The Office Action alleges that Peters teaches, at Column 15, lines 27-55, “the resolution being based on the payment provided by the customer.” Applicants respectfully traverse this interpretation of the description in Peters. The cited portion describes deciding how to refund a customer’s payment based on the type of payment submitted (credit card vs. cash). Refunds to the credit card may be authorized by a CSR site operator, while cash payments must be refunded by mail. [See, Column 15, lines 27-41].

Accordingly, contrary to what is alleged in the Office Action with respect to claim 43 (now cancelled), nothing in this description of how, in Peters, different types of refunds may be provided for different types of payments teaches or appears to suggest any consideration of the amount or value of those payments or refunds, much less any *assessed value of the customer*, as was recited in claim 43.

Applicants submit that Peters also does not teach wherein a resolution is based on at least one of *an identity of the customer or an assessed genuineness of the information provided by the customer*; the Office Action does not assert otherwise.

Accordingly, at least for these reasons and at least because the Examiner has failed to show how Peters teaches or suggests *wherein the resolution is based on at least one of: (i) an identity of the customer; (ii) an assessed genuineness of the information provided by the customer; (iii) an assessed value of the customer*, the Examiner has failed to establish a *prima facie* case that Peters anticipated claim 43.

Claim 39 has been amended and now recites *wherein the resolution is based on at least one of: (i) an identity of the customer and (ii) an assessed value of the customer*, and thus includes subject matter previously recited in claim 43. For the reasons stated above, the Office Action failed to establish a *prima facie* case of anticipation of claim 43 and Peters does not teach these features. Accordingly, Applicants incorporation of subject matter into claim 39 that was already examined in claim 43, and for which no *prima facie* case was made with respect to claim 43, cannot necessitate a final office action where the combination of the features of amended claim 39 was already considered by the Examiner in the examination of claim 43.

Applicants therefore respectfully request that this §102(b) ground for rejection of claims 39-42 be **withdrawn**.

C. 35 U.S.C. §103(a) – Walker, PTS

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker and PTS. Claim 5 stands rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of PTS, in further view of Whitten. Claim 6 stands rejected under 25 U.S.C. §103(a) as being allegedly unpatentable over Walker, PTS and Wittern Jr. Claims 2-4 depend from claim 1. Applicants traverse these grounds for rejection as follows.

I. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for

these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims 1-6 at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims 1-6.

Applicants therefore respectfully request that these §103(a) rejections of claims 1-6 be **withdrawn**.

b) Factual Inquiries Not Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of

the factual determinations required by *Graham v. John Deere*, including resolving the level of ordinary skill in the pertinent art. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and PTS (and/ or Whitten and / or Wittern Jr.) to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims 1-6 should therefore be **withdrawn**.

A. 35 U.S.C. §103(a) – Walker, Kolls

Claims 7-8, 17, 19-22, and 25-29 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Kolls. Claims 9 and 10 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Kolls and in further view of PTS. Claims 11 and 18 stand rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr. Claim 12 stands rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr. and Peters. Claim 13 stands rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr. and LeMay. Claims 14 and 15 stand rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr. and Blad. Claim 16 stands rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Wittern Jr., Blad and PTS. Claims 23, 24 and 30 stand rejected under 35 U.S.C. §103(a) Walker in view of Kolls and in further view of Whitten.

Applicants traverse these grounds for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to

combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims 7-30 at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims 7-30.

Applicants therefore respectfully request that these §103(a) rejections of claims 7-30 be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner's unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and Kolls to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims 7-30 should therefore be **withdrawn**.

B. 35 U.S.C. §103(a) – Walker, Joshi

Claims 31-38 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Walker in view of Joshi. Applicants traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Obviousness

The Examiner has failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth any reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine/Modify is Evident

The Examiner has failed to establish a *prima facie* case for obviousness for any of claims 31-38 at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to combine and/or modify the cited references to read on the pending claims.

The Examiner merely asserts that “it would have been obvious” to combine the cited references to read on the above-noted claims. Applicants respectfully note that the Examiner’s opinion does not constitute evidence, much less the substantial evidence required to support a *prima facie* case of obviousness.

Accordingly, at least because the Examiner has (i) failed to provide or describe any reason one would have had to combine and/or modify the cited references and (ii) failed to support any reason to combine/modify with *any* evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **31-38**.

Applicants therefore respectfully request that these §103(a) rejections of claims **31-38** be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquiries that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (e.g., secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved *any* of the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, the Examiner’s unsupported conclusory statement that it would have been obvious to combine and/or modify Walker and Joshi to achieve the claimed embodiments, is entirely meaningless.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **31-38** should therefore be **withdrawn**.

IV. New claims 44 and 45 contain allowable subject matter

For at least the reasons stated with respect to independent claim 39, from which new claims 44 and 45 depend, Applicants submit that claims 44 and 45 are directed to allowable subject matter. No new matter has been added (see, e.g., published application at [0144] – [0147], [0168], [0169]).

V. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Office Action does not imply agreement therewith.

If there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-438-6867 or via e-mail at cfincham@finchamdowns.com, at the Examiner's convenience.

VI. Petition for Extension of Time to Respond and Fees

While no fees are believed to be due at this time, please charge any fees that may be required for this Response to Applicants' Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Response timely, and please charge any fee for such an extension to Applicants' Deposit Account No. 50-0271.

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Date

Respectfully submitted,
/Michael Downs 50252/
Michael D. Downs
Attorney for Applicants
Registration No. 50,252
Fincham Downs, LLC
mduffy@finchamdowns.com
(203) 438-6408 /voice
(203) 438-6991 /fax